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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,230	02/04/2002	John T. Vaughey	215	7626

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EMRICH & DITHMAR  
125 South Wacker Drive  
CHICAGO, IL 60606

EXAMINER

CHANEY, CAROL DIANE

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/068,230	<b>Applicant(s)</b> VAUGHEY ET AL.	
	<b>Examiner</b> Carol Chaney	<b>Art Unit</b> 1745	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5-28-04.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 14-22 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Claim Rejections - 35 USC § 112***

Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially the same as" in claims 21 and 22 is a relative term which renders the claim indefinite. The term "substantially the same as" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The degree to which x-ray diffraction patterns should correspond, and the features which should correspond are not described.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, and 14-17 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Shimamura et al., US Patent 6,090,505, with evidence

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provided by Hultgren et al., editors, "Selected Values of the Thermodynamic Properties of Binary Alloys", American Society for Metals, pages 787 and 789, 1973.

Shimamura et al. disclose negative electrode materials for nonaqueous batteries. Batteries using the inventive anode materials are disclosed by Shimamura et al. (See Table 2B, columns 17 and 18.) The anode material includes a core formed by a solid phase A and an solid phase B. Solid phase B at least partially covers core A. Phase B may be an intermetallic compound. (See column 3, lines 35-60.) One example of the second embodiment of the Shimamura et al. invention is sample 41, which comprises a copper/antimony solid solution as phase A and  $\text{Cu}_2\text{Sb}$  as phase B. (See columns 17 and 18, and column 8, lines 48-53.) In the second embodiment, the composite particles are formed by peritectic reaction. (Column 7, line 66-column 8, line 5.) As can be observed from the Cu-Sb phase diagram, the formation of  $\gamma$ -phase  $\text{Cu}_2\text{Sb}$ , which is a tetragonal structure and thus crystalline, results from a peritectic reaction of 32 at% Sb 68 at% Cu system. (Evidence provided by Hultgren et al., editors, "Selected Values of the Thermodynamic Properties of Binary Alloys", American Society for Metals, pages 787 and 789, 1973.)

With regards to claims 8-10, the recitations of "0 atom percent or less" and "to the extent of 50 atom percent or less" are interpreted as encompassing 0 atom percent, so that the Shimamura et al. disclosure of  $\text{Cu}_2\text{Sb}$  anode materials meet the limitations of applicants' claims 8-10.

***Claim Rejections - 35 USC §102/103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-22 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shimamura et al.

Claims 18-20 are directed to intermetallic negative electrode materials of the form  $M_2M'$  with a  $Cu_2Sb$  crystal structure. The  $Cu_2Sb$  material formed by peritectic reaction as described by Shimamura et al. are assumed to be identical to the materials formed in the instant invention by ball-milling because there is no evidence to the contrary. The patentability of a product is independent of how it was made, and the burden is on applicants to show product differences in product by process claims. Ex parte Jungfer 18 USPQ 1796, 1800 (BPAI 1991); Bristol-Myers Co. v. U.S. International Trade Commission 15 USPQ 2d 1258 (Fed. Cir. 1989). In re Thorpe 227 USPQ 964 (Fed. Cir. 1985); In re Best 195 USPQ 430 (CCPA 1977).

With regards to claims 21 and 22, the Shimamura et al. invention and applicants' invention recite identical materials, which will inherently produce identical x-ray diffraction patterns.

Therefore applicant's negative electrode materials are anticipated by Shimamura et al. or in the alternative, would have been obvious to one of ordinary skill in the art based upon the prior art of Shimamura et al.

***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Lithium nonaqueous electrolyte batteries with negative electrode materials of the form  $M_2M'$  with a  $Cu_2Sb$  structure and  $M'$  as either P or As.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol Chaney whose telephone number is (571) 272-1284. The examiner can normally be reached on Mon - Fri 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Carol Chaney  
Primary Examiner  
Art Unit 1745

31 August 2004